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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,072	07/22/2003	Richard Milic	FA-1156 US NA	9445

23906 7590 12/23/2004

E I DU PONT DE NEMOURS AND COMPANY  
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WILMINGTON, DE 19805

EXAMINER
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SASTRI, SATYA B

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/625,072

Applicant(s)

MILIC, RICHARD

Examiner

Satya B Sastri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-14 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/22/03, 10/6/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. This office action is in response to application filed on July 22, 2003. *Claims 1-14* are now pending in the application.

### *Specification*

2. The use of the trademarks have been noted in this application in pages 9, 11-15. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. *Claim 1* is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The composition as recited in *claim 1* includes 10-60% of an aqueous dispersion of a binder resin constituting at least 15 wt.% water and as component (g), 3-30wt.% of water. It is

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unclear if (g) includes the water content of component (a). Additionally, (c) includes 5 to 70% of filler material and (f) includes 0.01 to 15 wt.% additives, pigments and fillers. The inclusion of filler material twice in the composition is confusing and renders the claim vague and indefinite.

5. **Claim 7** is vague and indefinite for the ambiguity that "low levels" introduces in the claim language. The instant specification does not provide definitions or guidance for the phrase "low levels" used in the claim language.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. *Claims 1-8, 9-14* are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, 17-24 of copending Application No. 10/423,362. Although the conflicting claims are not identical, they are not patentably distinct from each other because the prior filed application includes components a) through f) of instant claim 1. Although 10/423,362 does not explicitly disclose the use of water, the open claim language “comprising,” in 10/423,362 warrants an obviousness-type double patenting rejection of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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9. *Claims 1-5, 8-14* are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. (US 6,649,688 B1) in view of Dworak et al. (US 6,423,771 B1).

The prior art to Mayer et al. relates to coating compositions comprising component (I) comprising at least one hydroxyl-containing oligomeric or polymeric resin dispersed or dissolved in one or organic, optionally water dilutable solvents, as binder, a component (II) comprising at least polyisocyanate dispersed or dissolved in one or organic, optionally water dilutable solvents, as crosslinking agent, and component (III) which comprises water, wherein component (I) comprises at least one hydroxyl-containing polyacrylate resin (abstract). Binder resins of component (i) may comprise acrylate polymers, polyester resins and polyurethane resins (column 4, lines 39-65). Crosslinking agents disclosed include organic polyisocyanates containing free isocyanate groups attached to aliphatic, cycloaliphatic and/or aromatic moieties (column 19, lines 17-67). More specifically, the coating composition may include 15-60% by weight of binders, 5-30% of crosslinking agents, 5-25% organic solvents, 20-60% water, 0-50% by weight of pigments and/or fillers, 0-10% of customary additives and 0-40% of radiation curable constituents (column 24, lines 1-18). Examples of suitable fillers include chalk, calcium sulfate, barium sulfate, silicates such as talc, silica, aluminum hydroxide, nanoparticles or organic fillers such as fibers and wood flour. The compositions may be used in OEM finishing and in refinish of automobile bodies (column 25, lines 9-32).

The difference between the prior art and the present invention is that the present invention includes ground polymeric filler in amounts ranging from 1 to 40% by weight and 5 to 70% of filler material.

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The primary reference teaches the use of 0-50% by weight of pigments and/or fillers in the coating compositions and includes a variety of inorganic and organic fillers. Secondary reference to Dworak et al. teaches aqueous coating compositions for automotive surfaces (abstract). The prior art teaches that inorganic fillers and organic fillers may be used in the coating compositions. Inorganic fillers disclosed include barium sulfate, chalk, talc and organic fillers disclosed include those based on ground thermoplastics such as polyolefins, polyesters or polyamides (column 9, lines 1-10). Given the functional equivalence of the inorganic and organic fillers, it would have been obvious for one of ordinary skill in the art at the time the invention was made to include inorganic and/or organic ground thermoplastics in the coating compositions of Mayer et al. and thereby obtain the present invention.

***Allowable Subject Matter***

10. ***Claims 6, 7*** are objected to as being dependent upon a rejected base claim. Claim 6 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 7 would be allowable if rewritten (1) to overcome the rejection under 35 U.S.C. 112, second paragraph set forth in the office action and (2) in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

***Claims 6, 7*** are directed to a binder compositions comprising a ground polymeric filler comprising 2 to 30% PMMA containing filler and compositions comprising a ground polymeric filler consisting of about 40% PMMA and 60% aluminum hydroxide and other additives at low

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levels. Such modifications are not taught or suggested by the combined teachings of Mayer et al. and Dworak et al.


*Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 212 1112.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (571) 212 1114.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SATYA SASTRI

December 16, 2004

TATYANA ZALLIKAEVA  
PRIMARY EXAMINER

